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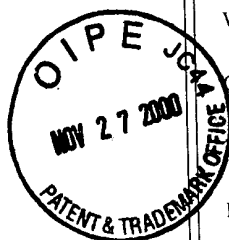
TOWNSEND and TOWNSEND and CREW LLP

By:

Malvinda W. Aguiar

Attorney Docket No.: 18941-0007-10
Client Reference: **RECEIVED**

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Election
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Lemaux *et al.*

Application No.: 09/384,811

Filed: August 27, 1999

For: TRANSPOSON TAGGING AND
GENE DELIVERY IN SMALL GRAIN
CEREALS

Examiner: Cynthia Collins

Art Unit: 1638

RESPONSE TO RESTRICTION
REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

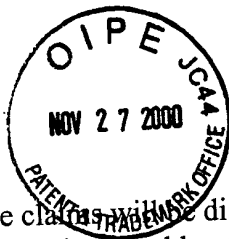
Sir:

In response to the Restriction Requirement mailed October 24, 2000, Applicant elects Group I, claims 1-16.

The foregoing election is made with traverse, as the two groups set forth by the Examiner all stem from a common concept and theory and are thus related. As such, prosecution of the claims of both groups together would not place a substantially greater burden on the Examiner.

In particular, Applicants note that the Examiner has indicated that claims 1-8 would only be examined to the extent that they read on the elected Group. On its face, this is improper. Placing claims 1-8 each in two separate groups is a *de facto* rejection of the patentability of the claims because the claims cannot issue as drafted. As the C.C.P.A. noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction



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requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *In re Weber, Soder and Boksay*, 198 USPQ 328, 331 (C.C.P.A. 1978). See also *In re Haas*, 179 USPQ 623, 624-625 (C.C.P.A. 1973) (*In re Haas I*); and *In re Haas*, 198 USPQ 334, 334-337 (C.C.P.A. 1978) (*In re Haas II*). See also MPEP § 803.02.

In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In re Weber*:

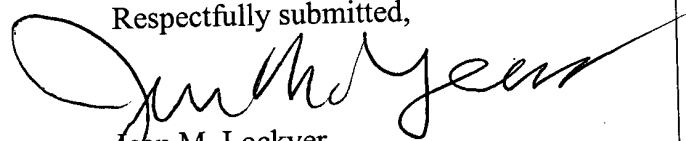
The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-no matter how broad, which means no matter how many independently patentable inventions may fall within it.
In re Weber, 198 USPQ at 334.
328

Therefore, in refusing to examine claims 1-8 in their totality, the Examiner is effectively making an improper rejection of the claims.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the Restriction Requirement and consider all the claims together.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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